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09249384

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/249,384 02/12/99 ANDERSON

D A-12222-US (C)

EXAMINER

HM12/1012

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ART UNIT 1, 5 PAPER NUMBER

1621

DATE MAILED:

10/12/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 98810114.3, filed on February 13, 1998 in Europe.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3, 6, 7, 11-14 are rejected under 35 U.S.C. 103(a) over Kaufmann et al. (US5334750, 1994) or, alternatively, Florent et al (FR2736354, 1997).

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Kaufmann et al (columns 2 and 4), or alternatively Florent et al. (Page 3) teaches compounds of formula I wherein R^1 is an aliphatic or aromatic hydrocarbon, R^2 is a hydrogen, R^3 is a hydrogen and X is a hydroxy group.

Kaufmann et al. and Florent et al. differ from the instant application in the length of the aliphatic and aromatic carbon chain, R^1 . For example, the aliphatic hydrocarbon chains are defined in Kaufmann et al. and Florent et al. as C1-C20 and C1-C10, respectively. In the instant application, R^1 is a C10-C30 aliphatic or aromatic hydrocarbon residue. In addition, the instant invention recites that the acrylic double bond is of the E-configuration, which is apparent from Kaufmann et al and Florent et al drawings.

It would have been obvious to an individual with ordinary skills in the art to determine that the acrylic double bond must be in the E-configuration because the resulting cinnamic acid derivatives would be more stable than corresponding ones with the double bond in the cis-configuration.

Claim Rejections - 35 USC § 112

5. Claim 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 8-10 recite the use of "Olfactory" alcohols, aldehydes and ketones. It is not clear as to what extent does "Olfactory" limit the genus of the alcohols, aldehydes and ketones.

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Claims 12 -14 recite a compound but does not define all of the atoms and bonds in the compound.

Claims 15-18 provide for the method of use of compositions, which upon "activation" yield organoleptic, antimicrobial or fluorescent whitening properties. The claims do not set forth any steps involved in the method/process, and it is unclear whether "activation" is required or not to meet the claim(s)?

Any inquiry concerning this communication or earlier ones from the examiner should be directed to **Dr. Sherif A. Kafafi** whose telephone number is **(703) 305-0509**. The examiner can be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gary Geist**, can be reached on **(703) 308-1701**. The fax telephone number for the organization where this application or proceeding is assigned is **(703) 308-4556**.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 308-1234**.

Sherif A. Kafafi, PhD



October 4, 1999.

Patent Examiner, Art Unit 1621.



PAUL J. KILLOS
PRIMARY EXAMINER
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Acting SPC